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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,350	02/13/2004	Brian Hyde	EAR	5072

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EXAMINER	
GOLOBOY, JAMES C	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/777,350	HYDE, BRIAN	
	Examiner	Art Unit	
	James Goloboy	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☒ Claim(s) *2-5, 8-12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 2-5 and 9-12 are objected to because of the following informalities: The word "preferred" and the phrase "more preferred" should be deleted. Appropriate correction is required.

2. Claim 8 is objected to because of the following informality: The dollar sign ("$") should be replaced by a percentage sign ("%"). Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-14 recite trade names for various lubricant additives. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. See MPEP § 2173.05(u).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abramowski (U.S. Pat. 6,521,569) in view of Dorrell (U.S. Pat. No. 4,336,150), Ciba Specialty Chemicals (http://www.cibasc.com/index/ind-index/ind-lub-2/ind-lub-products/ind-lub-pro-corrosion-inhibitors/ind-lub-pro-cor-sarkosylo.htm and http://www.cibasc.com/index/ind-index/ind-lub-2/ind-lub-products/ind-lub-pro-corrosion-inhibitors/ind-lub-pro-cor-amineo.htm), Papay (U.S. Pat. No. 5,652,201), and Cuse (U.S. Pat. No. 5,939,367).

In column 1 lines 10-14, Abramowski discloses a non-flammable lubricant composition, as recited in Claim 5. In column 4 lines 18-19 Abramowski teaches that the

lubricant comprises 4 to 20% by weight of an oil, and in column 4 line 30 discloses that the oil may be mineral oil (petrolatum). In column 4 lines 63-65 Abramowski teaches that the lubricant further comprises from 54 to 90% by weight of a nonflammable solvent, and in column 4 lines 67 teaches that the solvent is chlorinated. In column 5 lines 29-34 Abramowski discloses the use of 0.5 to 5% by weight of carbon dioxide in the composition as a propellant, and in column 5 lines 50-54 discloses 0.1 to 0.5% percent by weight of a fragrance additive. Abramowski also teaches, in column 5 lines 48-50, the addition of 0.5 to 5.5% by weight of a corrosion inhibitor. The differences between Abramowski and the currently presented claims are:

i) Abramowski teaches a chlorinated solvent, but not trichloroethylene.

ii) Abramowski teaches the addition of a fragrance additive, but not specifically methyl salicylate.

iii) Abramowski teaches a corrosion inhibitor, but not specifically SARKOSYL O and Amine O.

iv) Abramowski does not teach an antiwear/extreme pressure additive.

With respect to i), Abramowski teaches in column 5 lines 13-15 1,1,1-trichloroethane "and similar solvents" as a chlorinated solvent. Aside from the obvious similarity in chemical structure, Dorrell, in column 1 lines 32-33, teaches that trichloroethylene and 1,1,1-trichloroethane are both suitable liquid media for a lubricant composition. Trichloroethylene used in the concentration range taught by Abramowski meets the limitations of Claims 1-7.

With respect to ii), Cuse, in column 6 line 52 discloses a methyl salicylate odorant present as 0.5% by weight in a lubricant composition, meeting the limitations of Claims 1-7.

With respect to iii), the Ciba Specialty Chemicals webpages teach SARKOSYL O as a corrosion inhibitor, and that it is particularly effective when used in combination with Amine O.

With respect to iv), MONALUBE 225, as recited in Claims 1, 2, and 7, is a phosphate ester. Papay, in column 43 lines 51-60, teaches that phosphate esters are suitable for use as an antiwear/extreme pressure additive in lubricant compositions. In column 50 line 50 Papay teaches that the antiwear/extreme pressure additive preferably makes up 0 to 2% of the composition, overlapping the concentrations recited in Claims 1, 2, and 7. Papay, in column 50 lines 45-55 also discloses a range of 0 to 3% by weight of a corrosion inhibitor, encompassing the ranges recited in Claims 1 and 7.

The combination of the components and concentrations taught by Abramowski, Dorrell, Cuse, Ciba Specialty Chemicals, and Papay forms a lubricant composition that meets all the limitations of Claims 1-7.

It would have been obvious to one of ordinary skill in the art to use trichloroethylene, as taught by Dorrell, as it is less ozone-depleting than 1,1,1-trichloroethane. It would have been obvious to use methyl salicylate as a fragrance as its wintergreen odor would mask unpleasant odors from other lubricant components. It would have been obvious to use SARKOSYL O and Amine O as corrosion inhibitors due to their synergistic properties, as taught by Ciba Specialty Chemicals. It would have

been obvious to use a phosphate ester antiwear additive, as taught by Papay, as such additives are well known in the art to impart protect to metal surfaces under extreme pressure conditions.

8. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abramowski in view of Dorrell, Ciba Specialty Chemicals, Papay, and Cuse as applied to claims 1-7 above, and further in view of Lambert (U.S. Pat. No. 5,888,947).

The combination of Abramowski, Dorrell, Ciba Specialty Chemicals, Papay, and Cuse discloses a lubricant composition, but not a method of using the lubricant to reduce wear on metal surfaces due to extreme pressure conditions.

Lambert teaches in column 1 lines 21-28 that metal-to-metal contact between moving parts leads to wear, and in lines 29-33 teaches that lubricants can reduce wear between moving metal surfaces by forming a film between them. Using the lubricant composition of of Abramowski, Dorrell, Ciba Specialty Chemicals, Papay, and Cuse in the method of reducing wear taught by Lambert meets claims 8-14.

It would have been obvious to use the lubricant composition of Abramowski, Dorrell, Ciba Specialty Chemicals, Papay, and Cuse to contact moving parts in an environment which experiences extreme pressure conditions, such as an internal combustion engine, which experiences extreme pressure conditions in order reduce wear on metal surfaces, as taught by Lambert in column 1 lines 21-33 and Lambert's Claims 11 and 18.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Obermeier (U.S. Pat. No. 3,657,129) discloses a lubricant composition comprising ~80% by weight of a chlorinated oil and ~15% by weight of mineral oil.

Lowe (U.S. Pat. No. 3,928,218) discloses a lubricant composition comprising liquid petrolatum and trichloroethylene.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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